

REMARKS

This paper is filed in response to the Office Action dated February 26, 2004. As this paper is filed on June 28, 2004 with a one-month extension of time (June 26 being a Saturday and June 27 being a Sunday), the paper is timely filed.

I. Status of Amendments

Claims 1-27 were pending prior to this amendment. By this amendment, applicant cancels claims 1-27 without prejudice to refile, and adds claims 28-36. Thus, claims 28-36 are now pending.

Because applicant previously paid fees for 3 independent and 27 total claims, no additional fee is required.

II. Response to Office Action

A General Comments

Although the application describes various embodiments and makes various statements regarding the “invention,” it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term “invention” may be used to mean various different things.¹ For example, the term

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term “invention” is defined as follows:

INVENTION – In patent law, the word ‘invention’ has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

“invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘_____’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. § 112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of § 112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of § 112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112”).

B. The February 26 Office Action

In regard to the February 26 Office Action, applicant has the following comments.

1. Objections to the Specification

The specification was objected to as allegedly failing to provide proper antecedent basis for the subject matter of claims 16 and 23. Claims 16 and 23 have been cancelled, thus mooted the rejection. Applicant further notes that the term “player marker” is not recited in any of the presently pending claims.

2. Objections to the Claims

Claims 4, 7, 15, 22 and 23 were objected to because of several alleged informalities. Claims 4, 7, 15, 22, and 23 have been cancelled, thus mooted the objections.

3. Rejections based on 35 U.S.C. 112, second paragraph

Claims 16-21 were rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite. Claims 16-21 have been cancelled, thus mooted the rejections.

4. Rejections based on 35 U.S.C. 103

Claims 1-15 were rejected under 35 U.S.C. 103 as being allegedly unpatentable over Seelig et al. (U.S. Published Application No. 2003/0036418), claims 16-21 as being allegedly unpatentable over Weiss (U.S. Patent No. 6,582,303), and claims 22-27 as being allegedly unpatentable over Seelig et al. in view of Weiss. Claims 1-27 have been cancelled, thus mooted the rejections. However, applicants have the following comments regarding Seelig et al. and Weiss in the context of the presently pending claims.

While there is a base game and a bonus game in Seelig et al. (see, for example, paragraph [0019]), Seelig et al. does not disclose, teach or suggest for example, being awarded at least one resource item according to an event that occurs in the base game, which resource item may be selected by the player and matched to a processor-selected resource item in the bonus game. Seelig et al. does not disclose, teach or suggest any connection between the base game and the bonus game, other than the statement that the outcome of the base game may qualify the player for an opportunity to play a bonus game. *See, e.g.*, paragraph [0019], lines 5-7. In this regard, applicants particularly dispute that paragraph [0052] discloses, teaches or suggests that the player is provided “credits at the results of the base game for playing the bonus game.” Based on the grammar and syntax of paragraph

[0052], it would appear that paragraph [0052] states two assumptions: (i) “that the result of the base game is a win” and (ii) “that the player qualifies for a bonus of 10 coins or credits.” There is nothing in this statement that expressly states that the credits are awarded based on the fact that the base game is a win, and it is submitted that to suggest such is to impermissibly use applicant’s own specification as the motivation for reading the statement in the manner set out in the Office Action. In any event, there is nothing in Seelig et al. that suggests that the processor of Seelig et al. determines if at least one resource item awarded in the base game and selected by the player in the bonus game matches a processor-selected resource item.

Similarly, while there is a base game and a bonus game in Weiss (see, for example, col. 2:58-63), Weiss does not disclose, teach or suggest for example, being awarded at least one resource item according to an event that occurs in the base game, which resource item may be selected by the player and matched to a processor-selected resource item in the bonus game. As in Seelig et al., Weiss does not disclose, teach or suggest a connection between the base game and the bonus game, other than that the outcome of the base game is compared to a predetermined set of outcomes that trigger a bonus game. Col. 2:61-63. To the extent that Weiss states (at col. 3:1-8) that a “first indicia 40 is exposed to the player,” that the player “is allowed to select one card,” and that “[i]f the . . . card matches the first indicia 40, the player is awarded a bonus . . . “ as part of the bonus game, none of this discloses, teaches, or suggests any connection between the base game and this bonus game. Nor does Weiss disclose, teach or suggest that the results of subsequent bonus events rely on events occurring in prior bonus events, except to the extent that the player must successfully complete prior bonus events to play subsequent bonus events.

It is important to note that the claimed subject matter of claim 28 is not simply a matching game used as a bonus game. Rather, as will be recognized when claim 28 is viewed as a whole, the outcome of the bonus game may depend: (i) on the events in the base game, for these events determine which resource items are awarded to the player and included in the player resource item set, (ii) on player selection during the bonus game, for as part of the bonus game the player selects at least one of the resource items from the player resource item set, and (iii) on the events of the bonus game, for the processor must also select a resource item from the set of possible resource items during the bonus game and determine if a match has occurred with the player-selected resource item. This interrelationship

between base game play and bonus game play is nowhere disclosed, taught or suggested by Seelig et al. and Weiss, whether taken individually or in combination. Consequently, claim 28 should be allowable.

Moreover, as claim 28 is allowable, so too are claims 29-36 that depend from claim 28.

C. The Supplemental Information Disclosure Statement

Enclosed herewith is a Supplemental Information Disclosure Statement in regard to the above-mentioned application.

By this Supplemental Information Disclosure Statement, applicant cites U.S. Patent Application No. 10/027,928 ("the '928 application"), U.S. Published Application No. 2003/0119580, which is the published version of the '928 application, U.S. Patent Application No. 10/151,556 ("the '556 application"), and U.S. Patent No. 6,746,328, which corresponds to the '556 application. Further, applicant cites those documents not previously cited to or by the U.S. Patent and Trademark Office in the above-mentioned application that were cited to or by the U.S. Patent and Trademark Office during the prosecution of the '928 and '556 applications.

The undersigned also notes the following. One of the named co-inventors of the '928 application is the named inventor of the above-mentioned application. Moreover, the assignee of the '928 application at the time of filing, Anchor Gaming, was the assignee of the above-mentioned application at the time of filing. Further, the '928 application and the above-mentioned application were both transferred from Anchor Gaming to the present assignee, IGT. However, neither the undersigned nor his firm prepared the above-mentioned application or the '928 application, and the undersigned did not become aware of a relationship between the disclosure of the '928 application and the disclosure of the above-mentioned application until recently, when he reviewed Office Actions issued in regard to the '928 application and this application.

The undersigned further notes the following. The '556 application is presently assigned to IGT. However, the undersigned did not become aware of a relationship between

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the disclosure of the '556 application and the disclosure of the above-mentioned application until recently, when he reviewed the Office Action issued in regard to this application.

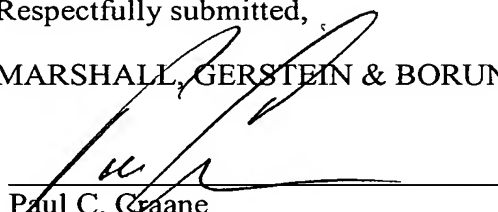
In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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